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Mailed: September 29, 2004

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re S. Goldberg & Co., Inc.

Serial No. 75941574

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Michael E. Zall, Esq. for S. Goldberg & Co., Inc.

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(David Shallant, Managing Attorney).

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Before Hairston, Bottorff and Holtzman, Administrative Trademark  
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by S. Goldberg & Co., Inc. to  
register the mark SG FOOTWEAR for the following goods, as  
amended: "Footwear distributed and sold directly to department  
stores, discount department stores and mass marketers."<sup>1</sup>

The trademark examining attorney has refused registration  
under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on  
the ground that applicant's mark, when applied to applicant's

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<sup>1</sup> Application Serial No. 75941574; filed March 13, 2000, alleging dates  
of first use and first use in commerce in August 1995. The word  
"footwear" is disclaimed.

goods, so resembles the registered mark shown below for "gloves, socks and scarves" as to be likely to cause confusion.<sup>2</sup>



When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.<sup>3</sup>

Here, as in any likelihood of confusion analysis, we look to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), giving particular attention to the factors most relevant to the case at hand, including the similarity of the marks and the relatedness of the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

We turn first to the goods. Applicant argues that the respective goods are not related, contending that the goods are not used in conjunction with each other and are not purchased together. Specifically, applicant argues that its goods are in restricted channels of trade, and that its goods are sold to professional buyers who are sophisticated and specialize in

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<sup>2</sup> Registration No. 1568528; issued November 28, 1989; renewed.

<sup>3</sup> Registration was also initially refused under Section 2(d) on the basis of an additional registration (no. 1996749). This refusal was withdrawn by the examining attorney in her brief.

buying footwear for stores and who are therefore not likely to be confused.

We find that shoes and socks are inherently related goods. They are complementary, and moreover companion articles of everyday wearing apparel which are purchased together and obviously worn together.

Although applicant's identification of goods is restricted to distributors and the wholesale market, registrant's identification contains no restriction at all. Therefore, both items can be sold in the same wholesale channels to the same professional buyers. Moreover, both applicant's and registrant's goods will ultimately be sold in the same retail market such as department stores, and perhaps even in the same sections of the stores, to the same consumer purchasers.<sup>4</sup> There is nothing in applicant's identification of goods or in the record to indicate that applicant's shoes are relabeled at the wholesale level or resold to end consumers without applicant's mark. It is clear that these closely related apparel items, if offered under similar marks, would naturally be perceived as emanating from the same source.

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<sup>4</sup> Unlike the case of *In re Shoe Works, Inc.*, 6 USPQ2d 1890 (TTAB 1988) where applicant restricted the channels of trade for its shoes to shoe stores, in the present case, the ultimate channels of trade for registrant's socks and applicant's shoes are not restricted to any particular types of stores. In any event, there is no reason to believe that socks, as companion items to shoes, would not be sold in shoe stores.

Thus, we turn our attention to the marks, keeping in mind that when marks would appear on closely related goods, the degree of similarity between the marks necessary to support a finding of likelihood of confusion declines. *Century 21 Real Estate v. Century Life*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applicant argues that the two marks are different in sound and distinctly different in appearance. Applicant contends that letter marks, unlike word marks, are incapable of being pronounced or of conveying any inherent meaning and maintains that the mere lettering style of registrant's should be sufficient to distinguish two the two marks. Applicant further argues that the word "FOOTWEAR" in its mark distinguishes one mark from the other because the word emphasizes the differences in the goods themselves.

While marks must be compared in their entirety, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

When we compare applicant's mark SG FOOTWEAR in typed form and registrant's mark SG in stylized form in their entirety, giving appropriate weight to the features thereof, we find that

the marks are similar and that the differences in the marks are not sufficient to distinguish them.

It is true that the style or design of letter marks may be sufficient to prevent a likelihood of confusion. However, in this case, only one of the marks contains a design. Applicant's mark is solely the typed designation "SG FOOTWEAR."

Moreover, while there is a design in registrant's mark, it is not purely a design mark. The letters SG are still an essential feature of registrant's mark. This is not a situation where the stylization of registrant's mark is so extreme and striking that when viewing the mark in its entirety, the stylization overwhelms the underlying letters making them virtually unrecognizable or so subordinate that they have no source-identifying effect. In this case, the letters are a significant component that contribute substantially to the overall commercial impression the mark conveys. In fact, it is the SG portion of the mark that would be used by purchasers to call for or request registrant's goods.

The letter combination SG is identical in both marks. It sounds the same when spoken and it has the same meaning. The disclaimed word "footwear" in applicant's mark does not overcome the similarity because it is a generic term having no source-indicating effect and it contributes little or nothing to the overall impression of the mark.

As for visual appearance, applicant's typed mark and registrant's letter and design mark are obviously dissimilar. However, it must be remembered that applicant seeks to register its mark in typed drawing form. Thus, in our likelihood of confusion analysis, we must consider all reasonable manners in which applicant could depict its mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983); and *INB National Bank v. Metrohost*, 22 USPQ2d 1585, 1588 (TTAB 1992). We recognize that a typed drawing registration for SG FOOTWEAR would only afford protection for all reasonable manners of presentation, not all possible forms no matter how extensively stylized. See *Jockey International Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992). Nevertheless, applicant could reasonably depict its mark in a style of lettering that, while not identical, would more closely resemble the stylization of registrant's mark. For example, if applicant presents its mark in tall, solid block letters, with part of the letter "S" overlapping the letter "G" the two marks would appear visually similar.

We also note that registrant's mark is entirely arbitrary as applied to shoes and there is no evidence of any third-party uses of similar SG marks for similar goods. Thus, registrant's mark is a strong mark which is entitled to a broad scope of

protection. See *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001). In addition, the fact that the marks comprise letters adds to the likelihood that the marks when used on related goods will be confused. See: *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

The ultimate purchasers of applicant's and registrant's shoes and socks are ordinary members of the general public, and the fact that these goods are common consumer items that may be purchased by the public with nothing more than ordinary care increases the risk of confusion. Even sophisticated purchasers would likely be confused when similar marks are used to identify these closely related goods. The fact that such purchasers may be sophisticated in their knowledge of the trade does not mean that they are sophisticated in their knowledge of trademarks. See *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742 (TTAB 1992).

The fact that there may have been no instances of actual confusion between the cited mark and applicant's mark is not particularly significant since there is no evidence in the record from which we can determine whether there has been any meaningful opportunity for confusion to occur. Nor do we have any information about whether registrant has encountered any confusion. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d

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1768 (TTAB 1992). Cf. In re General Motors Corp., 23 USPQ2d 1465 (TTAB 1992).

In view of the foregoing, we find that purchasers familiar with socks sold under registrant's mark SG and design would be likely to believe, upon encountering applicant's mark SG FOOTWEAR for shoes, that the goods originated with or are associated with or sponsored by the same entity.

To the extent that there is any doubt on the issue of likelihood of confusion, it is settled that such doubt must be resolved in favor of the prior registrant. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).

**Decision:** The refusal to register is affirmed.